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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/828,272 | 04/21/2004 | Toshiharu Nakajima | 61355-057 | 5442 |
| 7590 | 05/05/2005 | | EXAMINER | |
| McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096 | | | TO, TUAN C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3663 | |

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/828,272 | NAKAJIMA, TOSHIHARU |
| | Examiner Tuan C To | Art Unit 3663 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 January 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-8 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 21 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 04/21/2004.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Ohishi et al. (US 20010053956A1).

With respect to claims 1, 7, and 8, Ohishi et al. disclose a navigation system, comprising a storage device that stores user preference data classified by “recreation preferences”, “dining preferences”, and “relaxation preferences”. Thus, Ohishi et al. teaches the limitation: “an information storage device in which a plurality of different types of information to be provided to a user aboard a vehicle having an on-vehicle apparatus installed therein are stored”. The navigation system of Ohishi et al. also includes a voice recognition unit for recognizing predetermined words spoken by a user (Ohishi et al, page 1, paragraph 0008). As shown in figure 2, the spoken utterance recognition unit (61) for identifying the voice of each user and the audio guidance edited for each user is provided to that user (page 3, paragraph 0050). As illustrated in the patent, each user can have a conversation through an automatic response (Ohishi et al,

page 4, paragraphs 0071-0076). It should be noted the dialogue is between the user and the audio guidance of the system is generated via a telephone line (Ohishi et al., page 2, paragraph 0023). Thus, Ohishi et al. disclose the limitation: "an interactive voice response device having a speech recognition function that provides audio guidance edited for each user and engages in a dialogue with the user through automatic voice response via a telephone line". Ohishi et al. further teaches that when the user's preferences has been identified by the said conversation, the suggestion processor (78) (Ohishi et al, figure 2, processor 78) obtains information from the storage devices (75, 76, and 77). Also, the navigation system of Ohishi et al. includes a radio communication unit (21a) is a transmission unit as claimed. Therefore, the teachings of Ohishi et al. read on the limitation: "an information acquisition device that obtains information determined based upon the dialogue between the user and the interactive voice response device from the information storage device, and an information transmission device that transmits the information obtained by the information acquisition device to the on-vehicle apparatus".

With regard to claim 2, as discussed above, the interactive voice response provided in the Ohishi et al. patent is edited based on information pre-registered by the user (page 3, paragraph 0050).

With regard to claim 3, in the patent, a user is provided the auto guidance with a specific preference according to the user's conversation. The user can receive one type of information when the preference of the user has been retrieved (page 3, paragraphs 0057, 0058).

With regard to claims 4 and 5, Ohishi et al. disclose "the interactive voice response device tabulates information provided to a given user in the past and provides audio guidance customized for the user based upon tabulation results" (see page 4, paragraphs 0080, 0081).

With regard to claim 6, as discussed herein, the conversation between the user and the voice response of the navigation system is stored in the on-board vehicle system and that the contents of the conversation are indicated to the user.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (571) 272-6956.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/tc

April 29, 2005



WILLIAM G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 3600